



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AUG 12 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 35 and 48 of the morning section and questions 10, 23, 32 and 41 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On January 31, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 35 and 48 and afternoon questions 10, 23, 32 and 41. Petitioner's arguments for these questions are addressed individually below.

Morning question 35 reads as follows:

35. During their period of courtship, Amy and Pierre invented and actually reduced to practice an improved frying pan, wherein the sides and integral handle are formed from a metal having a low coefficient of conductivity, and a base providing the cooking surface formed from a metal having a high coefficient of conductivity. While the basic concept was old in the art, Amy's concept was to sandwich a layer of aluminum between layers of copper, while Pierre's concept was to sandwich a layer of copper between layers of aluminum. Accordingly, acting as pro se joint inventors, they filed a nonprovisional patent application in the USPTO on January 10, 2001, along with a proper nonpublication request. The application disclosed both Amy's and Pierre's concepts in the specification, and contained three independent claims: claim 1 was generic to the two concepts; claim 2 was directed to Amy's concept, and claim 3 was directed to Pierre's concept. Thereafter, Amy and Pierre had a "falling out" and Pierre returned to his home in France where he filed a corresponding patent application in the French Patent Office on January 31, 2001. Pierre was completely unaware of any obligation to inform the USPTO of the French application. Amy first learned of Pierre's application in the French Patent Office on October 10, 2001. Once Amy learns of the French application, which of the following actions should she take which accords with proper USPTO practice and procedure and which is in her best interest?

(A) Immediately notify the USPTO of the filing of the corresponding application in the French Patent Office.

(B) Promptly submit a request to the USPTO under Amy's signature to rescind the nonpublication request.

(C) File an amendment under Amy's signature deleting claim 3 and requesting that Pierre's name be deleted as an inventor on the ground that he is not an inventor of the invention claimed.

(D) Promptly file a document, jointly signed with Pierre, giving notice to the USPTO of the filing of the corresponding application in the French Patent Office and showing that any delay in giving the notice was unintentional.

(E) File an application for a reissue patent that is accompanied by an amendment paper with proper markings deleting Pierre's concept from the specification and a statement canceling claims 1 and 3.

The model answer is selection (D).

(D) is correct because 35 U.S.C. § 122(b)(2)(B)(iii) indicates that such action may avoid abandonment of the application. (A) is wrong because the action is being taken more than 45 days after filing of the corresponding application in the French Patent Office and thus will not avoid abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii). (B) is wrong because 37 CFR 1.213(a)(4) requires that the request be signed in compliance with

37 CFR 1.33(b)(4), which requires that all applicants sign. (C) is wrong because such action will not avoid abandonment of the application pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). (E) is wrong because Amy's application has not issued as a patent, and reissue relates only to applications that have issued as patents.

Petitioner argues that answer (C) is correct. Petitioner contends that (D) is wrong because (D) does not indicate that a foreign license was obtained.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is wrong because (D) does not indicate that a foreign license was obtained, there is no reason to assume that a foreign license was not obtained, particularly because the question has nothing to do with the policies regarding foreign licenses, and more to the point, petitioner has not shown why (C) would be correct, given that such action will not avoid abandonment of the application pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 48 reads as follows:

48. An Office action was mailed in which a three month shortened statutory period for reply was set. Four and one-half months after the mailing date of the Office action, the applicant submitted a fully responsive Amendment along with a petition and fee for a one-month extension of time. The petition for extension of time included an authorization to charge fees under 37 CFR 1.17 to applicant's deposit account. The applicant knew at the time the Amendment was filed that a two- month extension of time was required. Unfortunately, however, a clerical error was made that resulted in only a one- month extension of time being requested. Applicant overlooked this error when the amendment was filed. Assuming no further papers by applicant, which of the following statements is true?

- (A) The Amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.
- (B) The Amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.
- (C) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.
- (D) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension.
- (E) Each of statements (A), (B), (C) and (D) is untrue.

The model answer is selection (D).

MPEP § 710.02(e) at p. 700-77. (A) and (B) are not true because the amendment is treated as timely. (C) is incorrect because there is no authority for giving 30 days from the notification mailing date to request an extension time. 37 CFR 1.136; MPEP § 710.02(a). (E) is untrue because (D) is true.

Petitioner argues that answer (B) is correct. Petitioner contends that applicant failed to reply within the time period required by 37 CFR 1.134 and 1.136, resulting in abandonment, because of the half-month error in requesting an extension of time.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that applicant failed to reply within the time period required by 37 CFR 1.134 and 1.136, resulting in abandonment, because of the half-month error in requesting an extension of time, the petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension. MPEP § 710.02(e). 37 CFR 1.36(a)(3). Accordingly, model answer (D) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. Harriet filed a nonprovisional patent application in the USPTO containing a written assertion of small entity status. Based upon proper USPTO practice and procedure, which of the following statements is correct?

(A) If Harriet files a related, continuing application wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continuing application.

(B) If Harriet files a related, reissue application wherein small entity status is appropriate and desired, it will be necessary to specifically establish assertion of such status in the reissue application.

(C) If Harriet files a related, divisional application under 37 CFR 1.53, wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the divisional application.

(D) If Harriet refiles her application as a continued prosecution application under 37 CFR 1.53(d), wherein small entity status is appropriate and desired, it will not be necessary to specifically establish assertion of such status in the continued prosecution application.

(E) If Harriet subsequently assigns her rights to another party for whom small entity status is appropriate and desired, it will be necessary to specifically re-establish assertion of such status.

The model answer is selection (B).

(B) is correct and (A), (C) and (D) are wrong. 37 CFR 1.27(c)(4) ("The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application, including a continued prosecution application under § 1.53(d), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application."). (E) is also wrong. 37 CFR 1.27(e)(1) ("Where an assignment of rights... to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.")

Petitioner argues that answer (E) is correct. Petitioner contends that selection (E) suggests the assignee may not be a small entity and therefore it might be required to re-establish status.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (E) suggests the assignee may not be a small entity and therefore it might be required to re-establish status, the test instruction specifically warn the test taker to avoid unwarranted assumptions, and selection (E) specifically states that small entity status is appropriate for the assignee, in which case it cannot be necessary to re-establish status under 37 CFR 1.27(e)(1). Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 23 reads as follows:

23. Greene is a registered patent agent employed by an intellectual property law firm located in Arlington, Virginia. Greene is awakened at 5:30 AM one morning by a frantic call from Whyte, a senior partner at the law firm. Whyte informs Greene that Whyte has an examiner interview scheduled for 3:00 PM that day in connection with an important patent application Whyte is handling. However, a family emergency arose during the night and Whyte will not be able to attend the interview. It is also the last day of the statutory six-month period for reply, so the interview cannot be rescheduled. Whyte requests that Greene conduct the examiner interview for Whyte and, based on the outcome of the interview, file appropriate papers with the Patent Office. Whyte tells Greene exactly where Greene can locate the file in Whyte's office. Greene has not been given a power of attorney in the application, but has been given a power to inspect the Patent Office file for the application. Assuming Greene has adequate time to prepare for the interview and will competently represent the applicant, which of the following statements is true?

(A) Greene must obtain either a written power of attorney from the applicant or a written associate power of attorney from Whyte before Greene can participate in the examiner interview.

(B) Greene can participate in the interview if Greene brings along a copy of the application file and states to the examiner that Greene is authorized to represent the applicant.

(C) Greene cannot participate in the examiner interview because Greene does not have an express power of attorney and has not previously made an appearance in the application.

(D) A mere power to inspect is sufficient authority for an examiner to grant an interview involving the merits of an application.

(E) Statements (B) and (D) are true.

The model answer is selection (B).

MPEP § 713.05. Statements (A) and (C) are incorrect because Greene may participate in the interview if he possesses a copy of the application file and states he is authorized to represent the applicant. (D) is incorrect because a mere power to inspect is insufficient authority for an examiner to grant an interview involving the merits of an application. (E) is therefore also incorrect.

Petitioner argues that answer (E) is correct. Petitioner contends that (D) is also true, thus making (E) the best answer, because MPEP 713.05 states that an examiner may grant an interview to a known representative of one who has power of attorney.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (D) is also true, thus making (E) the best answer, because MPEP 713.05 states that an examiner may grant an interview to a known representative of one who has power of attorney, there is no indication in the fact situation that Greene is known by the examiner to be a representative of Whyte, and even if the examiner did so know, it would be that knowledge, and not the power to inspect, that would enable the examiner to grant the interview. Selection (D) posits that the power to inspect alone is sufficient, which MPEP 713.05 directly contradicts, as admitted by the petitioner. Accordingly, model answer (B) is correct, selection (D) is incorrect, and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 32 reads as follows:

32. Which of the following is true?

- (A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.
- (B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.
- (C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.
- (D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.
- (E) Each of statements (B) and (C) is true.

The model answer is selection (E).

As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

Petitioner argues that answer (B) is correct. Petitioner contends that selection (C) is not correct and therefore (E) is not the best answer, because MPEP 2203 indicates the Office may not be able to actually maintain confidentiality due to the clerical nature of entering art.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (C) is not correct and therefore (E) is not the best answer, because MPEP 2203 indicates the Office may not be able to actually maintain confidentiality due to the clerical nature of entering art, selection (C) only indicates that the submitter may so request, which the petitioner admits is so, and does not say anything about the Office's capacity to honor the request. Accordingly, model answer (E) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with USPTO proper practice and procedure?

(A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.

(B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.

(C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.

(D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.

(E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

The model answer is selection (C).

Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

Petitioner argues that answer (B) is correct. Petitioner contends that it is reasonable to assume that in selection (B), the reissue will be filed under Mark Twine's name, because Twine agreed to cooperate.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that it is reasonable to assume that in selection (B), the reissue will be filed under Mark Twine's name, because Twine agreed to cooperate, the test instructions specifically indicate that the test taker should not make unwarranted assumptions, selection (B) specifically states that the S. Clemens String Co., not Mark

Twine, files the reissue application, and selection (C) is the selection that actually lays out the pattern petitioner argued as a reasonable inference in selection (B), making selection (C) a better answer than selection (B). Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "R. J. Spar", is positioned above the printed name and title of the official.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy